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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Kimble	)	Art Unit: 2623
	)	
Serial No.: 09/835,300	)	Examiner: Huynh
	)	
Filed: April 13, 2001	)	50P3984.01
	)	
For: MEDIA ON DEMAND SYSTEM AND METHOD	)	April 25, 2007
	)	750 B STREET, Suite 3120
	)	San Diego, CA 92101
	)	

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**REPLY BRIEF**

Commissioner of Patents and Trademarks

Dear Sir:

This replies to the Examiner's Answer dated April 20, 2007. To the "related appeals" section Appellant would like to add application no. 10/060,644, in which an appeal was filed on April 17, 2007.

The Answer begins with an allegation that Appellant is "attacking references individually", a boilerplate macro of MPEP §707.07(f) that apparently has been loaded onto every PTO computer despite the exceptionally limited legal circumstances underpinning the supporting cases (Keller and Merck) discussed further below. There is absolutely no way for a patent applicant to discuss why references do not render claims unpatentable without actually discussing each reference and each citation to the reference, yet this ineluctable circumstance invariably leads to charges of "attacking references individually".

With greater attention to the law being relied on by the conferees, Keller dealt with a claim directed to a cardiac pacemaker. The applicant did not dispute that both of the primary references (a prior Keller patent, and Berkovits) taught everything in the claim except that the prior art used an analog timer, whereas

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the claim required a digital timer. The secondary reference (Walsh) taught that in a heart stimulator used to study the atrioventricular conduction system of a mammalian heart, a digital timer provided greater accuracy than an analog timer. The sole evidence provided by the applicant to rebut the *prima facie* showing was an affidavit that disputed that Walsh suggested using a digital timer in a pacemaker, as opposed to a heart stimulator. This was the argument against which the CAFC inveighed with a warning not to attack references individually, i.e., in the case where a patent applicant concedes everything about the primary references but in effect argues that the heart stimulator art was not sufficiently analogous to the pacemaker art to legitimize the otherwise well known principle that making a circuit digital instead of analog is obvious.

Against this backdrop of the case, Keller must be understood to state that attacking a secondary reference on dubious analogousness grounds while conceding everything else in the rejection is simply not sufficient to rebut an otherwise properly made *prima facie* case.

Merck cites Keller for a warning, in the context of a patent to an anti-depressant, not to attack references individually. However, in the Merck case the argument being discussed was that a secondary reference (Peterson) taught away from the claimed invention, which involved the interchange of nitrogen with unsaturated carbon atoms. This interchange was clearly shown to be isosteric by other prior art (the "Roche Reports"), meaning the claimed amitriptyline, which indisputably was structurally similar to the prior art imipramine, would be expected to exhibit similar bioactivity.

Accordingly, in the relevant parts of both Merck and Keller the applicants in effect conceded virtually everything in the rejections and instead focused in one case (Keller) on a dubious argument of non-analogousness of a secondary reference and in the other case (Merck) on an alleged teaching away that ignored other explicit teachings toward which were of record. There was thus no prohibition whatsoever against a

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patent applicant explaining defects in an examiner's application of individual references, defects in an examiner's failure to find a proper *prior art* motivation to combine, or defects in an examiner's understanding of the reference.

In the present case, Appellant has not "attacked references individually" as the term is used in the Keller and Merck cases. Instead, Appellant first argues that Zigmond et al. does not teach what the examiner alleges it does. This is not attacking Zigmond individually, it is attacking a misunderstanding on the part of the examiner which makes the rejections reversible.

Proving that he hit the macro button without understanding the legal issues at play, on the bottom of page 8 the examiner elides from "attacking references individually" to an argument irrelevant to "attacking references individually", namely, an argument to the effect that the claims do not contain argued features. Accordingly, turning to the merits of this argument, the examiner alleges that "video portion presented within a portion of a markup layer" and "protocol file that is downloaded in response to selection of a link" are not claimed.

The allegation is wrong for reasons explained in the Appeal Brief. To summarize, Claim 117 requires displaying a video program on the display in accordance with a protocol file including a TV channel corresponding to the video-on-demand associated with the selection and a size and location of a video layer within a markup language layer. Claim 114 recites a list of links, receiving a selection of a link, and then in response to the selection, sending a protocol file to the TV system. That Appellant has reworded these recitations into equivalent statements for brevity that plainly mean exactly the same thing is a poor reason for refusing to recognize right answer when told.

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Continuing with the evisceration of the Answer, the relied-upon attributes of Zigmond, as patiently explained to the examiner more than once, do not relate to the position of anything in a markup language page. They relate to reducing the standard TV image aspect ratio as appropriate for the display. In stating this, Appellant is not "attacking" Zigmond, individually or otherwise. Appellant simply is explaining why the examiner is wrong about what Zigmond teaches.

It may now be plainly understood that indeed, a prohibition against focusing on individual prior art features in isolation is being run roughshod over here. It is not, however, Appellant "attacking references individually". Instead, the conferees are picking and choosing isolated teachings from the prior art, creating new teachings from them with the hindsight benefit of the claims, and then cobbling it all together in an unsuggested way to arrive at the present claims. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art" In re Fine, 5 U.S.P.Q. 2d at 1600 (Fed. Cir. 1987), cited at MPEP §2143.01(I).

On page 10 of the Answer the examiner explains further that Fries sends something to the TV. Unfortunately, the thing that Fries sends, which has been interpreted to be a "protocol file", has nothing to do with the claimed protocol file, hence the (mistaken) resort to concocted teachings of Zigmond. Instead, Appellant is compelled to point out that Fries et al. nowhere mentions that the video program is presented within a portion of a markup layer, much less in accordance with the size and location defined by a protocol file, so why one would be motivated to download something from Zigmond that Fries does not need is unclear.


Page 10 concludes with a *non-sequitur* that has already been rebutted in the Appeal Brief.

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Respectfully submitted,



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